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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:
Date: 14 October 2005 Name: C. Noel Kaman, Reg. No. 51,857 Signature: C. Noel Kaman

BRINKS
HOFFER
GILSON
& LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Botstein et al.

Appln. No.: 09/944,944

Filed: August 31, 2001

For: SECRETED AND TRANSMEMBRANE
POLYPEPTIDES AND NUCLEIC ACIDS
ENCODING THE SAME

Examiner: Eileen B. O'Hara

Art Unit: 1646

Attorney Docket No: 10466/137 (P2548P1C18)

Mail Stop Patent Ext.
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

- ☒ Resubmission of Application for Reconsideration of Patent Term Adjustment Pursuant to 37 C.F.R. Section 1.705(b) with Exhibit A.
- ☒ Return Receipt Postcard

Fee calculation:

- ☐ No additional fee is required.
- ☐ Small Entity.
- ☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 C.F.R. § 1.136(a).
- ☐ A petition or processing fee in an amount of \$_____ under 37 C.F.R. § 1.17(_____).
- ☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			x 100=			x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=			+\$360=	
					Total	\$		Total	\$

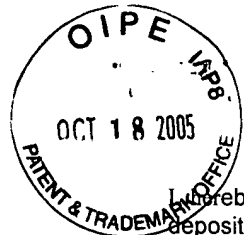
Fee payment:

- ☐ A check in the amount of \$_____ is enclosed.
- ☐ Please charge Deposit Account No. 23-1925 in the amount of \$_____ A copy of this Transmittal is enclosed for this purpose.
- ☐ Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

14 October 2005
Date

C. Noel Kaman
C. Noel Kaman (Reg. No. 51,857)



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October 14, 2005

Date of Deposit

C. Neal Kamen

Signature

Our Case No. **10466/137**
P2548P1C18

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Botstein *et al.*

U.S. Patent Application Serial No. **09/944,944**

Mailing Date of Notice of Allowance : **1/6/05**

Filing Date: **August 31, 2001**

Title: **SECRETED AND TRANSMEMBRANE
POLYPEPTIDES AND NUCLEIC ACIDS
ENCODING THE SAME**

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) Examiner: **Eileen B. O'Hara**
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) Group Art Unit No. **1646**
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**RESUBMISSION OF APPLICATION FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT
PURSUANT TO 37 C.F.R. § 1.705(b)**

Mail Stop Patent Ext
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Reconsideration of the patent term adjustment under 35 U.S.C. § 154(b) is requested.

- (1) According to the USPTO letter mailed June 6, 2005, the Office acknowledges receipt of the required fee under 37 C.F.R. § 1.18(e) of \$200.00 for an

application of patent term adjustment. Additionally, the Office states that no additional fee will be required if Applicant is solely requesting reconsideration of additional time related to failing to issue the patent within three years of the filing date.

(2) A statement of the facts involved:

- (i) According to the Issue Notification, the Patent Term Adjustment for this patent will be **444** days. Correction of the patent term adjustment to add an additional **245** days to the patent term is respectfully requested. Thus, Applicants respectfully submit that the proper total patent term adjustment for this application is **689** days.

The provisions of 37 C.F.R. § 1.702(a)(1)(2) provide the basis for term adjustment of **390** days as set forth in the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).

The provisions of 37 C.F.R. § 1.702(a)(4) provide the basis for term adjustment of **60** days as set forth in the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).

The provisions of 37 C.F.R. § 1.702(b) provide the basis for the additional **245** days of term adjustment requested herein.

- (ii) The relevant dates, as specified in 37 C.F.R. §§ 1.703(a), for which an adjustment is awarded are as follows:

- a) The period of adjustment under 37 C.F.R. § 1.703(a)(1) is the number of days, if any, in the period beginning on the day

("the fourteen month date") after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a) of fulfilled the requirements of 35 U.S.C. § 371 (the fourteen-month date) and ending on the date of mailing of either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151, whichever occurs first.

1. The present application was filed on **August 31, 2001**.
The fourteen-month date determined pursuant to 37 C.F.R. § 1.703(a)(1) is **October 31, 2002**.
2. The first notification under either 35 U.S.C. §§ 132 or 151 was not mailed until **September 9, 2003**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).
3. Thus, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A), under 37 C.F.R. § 1.702(a)(1), Applicants are entitled to **313** days of patent term extension.
4. The period of adjustment under 37 C.F.R. § 1.703(a)(6) is the number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied (the four month date) and ending on the date a patent was issued.
5. The issue fee was mailed on February 14, 2005 and received by the USPTO on **February 17, 2005** as

evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).

6. The four month date is therefore, **June 17, 2005**.
7. The present application issued as a patent on **August 16, 2005**.
8. Thus, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A), under 37 C.F.R. § 1.702(a)(4), Applicants might be entitled to **60** days of patent term extension, depending on whether that term must be reduced pursuant to the provisions of 37 C.F.R. § 1.704.
 - b) The period of adjustment under 37 C.F.R. § 1.703(a)(2) is the number of days, if any, in the period beginning on the day ("the four month date") after the date that is four months after the date a reply under §1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151, whichever occurs first.
 1. A response to the Non-Final Rejection mailed September 9, 2003 was filed **December 15, 2003**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).

2. The four month date for mailing either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151 is **April 15, 2004**.
3. A Final Rejection under 35 U.S.C. § 132 was mailed on **May 17, 2004**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).
4. Based on these events and as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A), under 37 C.F.R. § 1.702(a)(2), Applicants are entitled to **32** days of patent term extension.
5. A response to the Final Rejection mailed May 17, 2004 was filed **July 22, 2004**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A).
6. The four month date for mailing either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151 is **November 22, 2004**.
7. Based on these events and as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A), under 37 C.F.R. § 1.702(a)(2), Applicants are entitled to **45** days of patent term extension.
8. Thus, under 37 C.F.R. § 1.702(a)(2), Applicants are entitled to **(32 days + 45 days =) 77** days of patent term extension.

(iii) The relevant dates, as specified in 37 C.F.R. §§ 1.703(b), for which an adjustment is sought are as follows:

a) The period of adjustment under 37 C.F.R. § 1.703(b) is the number of days in the period beginning on the day ("the three year date") after the date that is three years after the date on which the application was filed under 35 U.S.C. § 111(a).

1. The present application was filed on **August 31, 2001**.
The three year date determined pursuant to 37 C.F.R. § 1.703(b) is **August 31, 2004**.
2. The patent issued on **August 16, 2005**. However, Applicants request **60** days of patent term adjustment under 37 C.F.R. § 1.703(a)(6) due to the delay in issuing the patent within 4 months of payment of the issue fee. Therefore, Applicants do not request these **60** days under the 3 year date rule as they overlap. Thus, the delay under this provision is measured to **June 17, 2005**, the date the patent should have issued.
3. Thus, under 37 C.F.R. §§ 1.702(b), for the delay ranging from **August 31, 2004** to **June 17, 2005**, Applicants should be awarded **290** additional days of patent term extension. However, **45** days of these **290** days overlap with the PTO delay incurred from **November 22, 2004** to **January 6, 2005**. Therefore, the **290** days must be reduced by **45** days, which leaves **245** days.

- (iv) U.S. Patent Application Serial No. 09/945,584 is not subject to any terminal disclaimer.
- (v) Circumstances during the prosecution of the application resulting in the patent that constituted a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704(b) include the following:
 - a) The Office mailed a First Non-Final Rejection on **September 9, 2003**. Applicants mailed an Amendment and Response on December 9, 2003, which was filed at the Office on **December 15, 2003**, as evidenced by the PAIR Patent Term Adjustment History (attached hereto as Exhibit A). Any response filed after the date that is three months after the date a rejection is mailed is subject to the provisions of 37 C.F.R. § 1.704(b). Indeed, the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying Applicant of the rejection and ending on the first day the reply is filed. Therefore, the adjustment set forth in § 1.703 must be reduced **6** days based on this transaction.
 - b) Therefore, under the provisions of 37 C.F.R. § 1.704, the adjustment set forth in § 1.703 must be reduced by a total of **6** days.

Patent App. Ser. No.: 09/944,944

Date Filed: Aug. 31, 2001

Mail Date of Notice of Allowance: January 6, 2005

1. Total patent term adjustment - For the present application, the total patent term adjustment under 37 C.F.R. § 1.703(f) is the period of adjustment under 37 C.F.R. § 1.703 reduced by the reduction under 37 C.F.R. § 1.704. The total adjustment is thus **313 days + 77 days + 60 days + 245 days - 6 days = 689 days**, not **444 days** as calculated by the Office.

Applicants respectfully request reconsideration of the patent term adjustment for this application. Office personnel are invited to contact the undersigned Attorney for Applicants via telephone if such communication would expedite this request.

Respectfully submitted,



C. Noel Kaman
Registration No. 51,857
Attorney for Applicants

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200

Patent Term Adjustment (PTA) for Application Number: 09/944,944			
			Days
Filing or 371(c) Date:	08-31-2001	USPTO Delay (PTO):	450
Issue Date of Patent:	08-16-2005	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL):	6
Post-Issue Petitions (days):	+0	Total PTA:	444
USPTO Adjustment(days):	+0	Explanation Of Calculations	
Patent Term Adjustment History			
Date	Contents Description	PTO(Days)	APPL(Days)
08-16-2005	Patent Issue Date Used in PTA Calculation	60	
07-27-2005	PTA 36 Months	↑↑	
07-14-2005	Receipt into Pubs	↑↑	
07-14-2005	Dispatch to FDC	↑↑	
07-14-2005	Application Is Considered Ready for Issue	↑↑	
07-05-2005	Receipt into Pubs	↑↑	
06-06-2005	Petition Decision - Dismissed	↑↑	
02-17-2005	Issue Fee Payment Verified	↑↑	
02-17-2005	Issue Fee Payment Received	↑↑	
02-16-2005	Petition Entered	↑↑	
02-16-2005	Workflow incoming petition IFW	↑	
02-16-2005	Sequence Forwarded to Pubs on Tape	↑↑	
01-25-2005	Workflow - File Sent to Contractor	↑	
01-06-2005	Mail Notice of Allowance	45	
01-05-2005	Issue Revision Completed	↑	
01-04-2005	Notice of Allowance Data Verification Completed	↑	
10-18-2004	Change in Power of Attorney (May Include Associate POA)	↑	
10-16-2004	Correspondence Address Change	↑	
07-29-2004	Date Forwarded to Examiner	↑	
07-22-2004	Amendment after Final Rejection	↑	
07-22-2004	Workflow incoming amendment IFW	↑	
05-17-2004	Mail Final Rejection (PTOL - 326)	32	
05-14-2004	Final Rejection	↑	
04-22-2004	IFW TSS Processing by Tech Center Complete	↑	
04-22-2004	Date Forwarded to Examiner	↑	
12-15-2003	Response after Non-Final Action	↑	6
09-09-2003	Mail Non-Final Rejection	313	
09-08-2003	Non-Final Rejection	↑	
04-22-2003	Case Docketed to Examiner in GAU	↑	
12-20-2002	Case Docketed to Examiner in GAU	↑	
09-03-2002	Preliminary Amendment	↑	
09-03-2002	Preliminary Amendment	↑	
05-01-2002	Information Disclosure Statement (IDS) Filed	↑	
02-11-2002	Case Docketed to Examiner in GAU	↑	
02-06-2002	Case Docketed to Examiner in GAU	↑	
02-06-2002	Case Docketed to Examiner in GAU	↑	
12-20-2001	CRF Is Good Technically / Entered into Database	↑	
11-28-2001	Case Docketed to Examiner in GAU	↑	
11-09-2001	Application Dispatched from OIPE	↑	
11-07-2001	Correspondence Address Change	↑	
10-26-2001	CRF Is Good Technically / Entered into Database	↑	

09-14-2001	IFW Scan & PACR Auto Security Review	↑	
08-31-2001	Preliminary Amendment	↑	
08-31-2001	CRF Disk Has Been Received by Preexam / Group / PCT	↑	
08-31-2001	Initial Exam Team nn		